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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,645	08/19/2003	Thomas Rathschlag	MERCK-2733	3760

23599 7590 01/10/2007  
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ARLINGTON, VA 22201

EXAMINER
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SPEER, TIMOTHY M

ART UNIT	PAPER NUMBER
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1775

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/10/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/642,645

Applicant(s)

RATHSCHLAG, THOMAS

Examiner

Timothy M. Speer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 16-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/20/06 has been entered.

### ***Restriction***

2. The restriction requirement set forth in the paper dated 03/25/05 is maintained. Accordingly, claims 16-20 are withdrawn from consideration and claims 1-15 and 21 will be treated on the merits.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 3, 5, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Wang (USPN 4,756,951).

5. Wang discloses a print product comprising a substrate, a layer of printing ink, a primer layer including platelet-shaped particles and a top layer of an overprint varnish (PVC plastisol) (Figure 3 and accompanying text; and col. 4, lines 12-15, 43, & 43-59). Regarding claim 3, Wang teaches that the particles may have a thickness in the range of 5-50 microns and a

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thickness of 0.06-0.09 microns (col. 6, lines 21-26). These ranges have endpoints within the ranges recited in instant claim 3 and, accordingly, Wang anticipates claim 3. Therefore, instant claims 1, 2, 3, 5 and 12 are considered to be anticipated by Wang.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4, 6-10, 13, 14, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang.

8. Wang was discussed above.

9. Regarding claims 4, 6, 7, 9 and 13, Wang teaches that the disclosed platelet shaped particles may be chosen from a group including mica (col. 5, line 11). Therefore, it would have been obvious to one having ordinary skill in the art to employ mica as the particles in the article of Wang, since Wang suggests mica particles. With respect to claim 6, it is the Examiner's position that since mica is a silicate, the mica particles suggested by Wang are within the scope of the phrase "based on a silicate," as employed in claim 6.

10. With respect to claim 8 and 10, Wang teaches that the article may include layers in addition to those illustrated, for example, in figure 3, and that such layers may additionally include platelet shaped particles (col. 4, lines 50-59). Therefore, it would have been obvious to one having ordinary skill in the art to include platelet shaped materials in one or more of the layers disclosed by Wang. The Examiner notes that the present claims do not require the

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"varnish" layer to be an outermost layer, since the present claims employ open transitional language, i.e., "comprising."

11. With respect to claim 11, Wang fails to teach the inclusion of at least one crosslinking agent. Wang, however, teaches that the various layers may contain "various additives known in the art" (see col. 4, lines 3-11, for instance). Crosslinking agents, and the properties imparted thereby, e.g., improved durability, are extremely old and well known in the art. Accordingly, it would have been obvious to one having ordinary skill in the art to employ a crosslinking agent in the articles of Wang, since such materials are known in the art and suggested by Wang.

12. In light of the above, it is the Examiner's position that the present claims are obvious in view of the applied prior art.

#### *Response to Arguments*

13. Applicant's arguments filed 10/20/06 have been fully considered but they are not persuasive. Applicant argues that Wang fails to teach that the particles are "aligned," as presently claimed, pointing out that Wang teaches that the particles disclosed therein may be "substantially oriented at two or more different angles." Applicant then concludes that this teaching indicates that the particles are not "aligned." This argument is wholly unpersuasive. Contrary to supporting applicant's assertion, the passage in Wang cited by applicant clearly indicates that the particles of Wang are, in fact, aligned; some at one angle and others at another. In any event, the particles are aligned and meet the limitations of the present claims.

14. It appears that applicant is attempting to define the term "aligned" more narrowly than is warranted. There is nothing in the term that requires alignment to be in only one orientation, as is apparently being urged by applicant.

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15. In light of the above, applicant's arguments have been considered, but are not found to be persuasive.

***Conclusion***

16. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

17. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Speer whose telephone number is 571-272-8385. The examiner can normally be reached on M-Th, M-F.

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19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on 571-272-1540. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Timothy M. Speer

  
JENNIFER MCNEIL  
SUPERVISORY PATENT EXAMINER  
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